

Application No. 09/324,249
Amendment date: September 13, 2004
Reply to Office Action of June 15, 2004

Remarks/ Arguments

Claims 1- 6, 8-21, 23-33 and 35 are currently rejected and remain in this application. Claim 34 is allowed and claims 12 and 22 is objected to. Applicant respectfully submits the following remarks and arguments with respect to claims rejected in the third Office Action in this case. Claims 12 and 22 are canceled and rewritten herein as new independent claims 36 and 37 to include all of the limitations of base claims 11 and 21 respectively.

Applicant has amended herewith the first sentence of the specification in order to correct the reference to prior provisional application 60/087,745 filed on 06/02/1998.

A supplemental oath or declaration is submitted herewith to correct inaccuracies noted in paragraph 2 of the latest Office Action.

Claim 10 is herewith amended to more properly reference the "Digital" apparatus of claim 9.

Claims 11-15 and 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

With respect to claim 11, Applicant respectfully submits that the "digital camera means" recited on line 8 is an element of the wireless digital camera apparatus recited on line 2, but has amended this claim to clarify the purpose of this camera element within the apparatus, which is to capture digital images in response to signals from the user interface. In reviewing this claim, Applicant noticed that "one said digital image" recited on line 12 lacked precedent, and the amendment submitted herewith to claim 11 also serves to establish a precedent for "said" digital image. Applicant respectfully submits that with this clarifying change claim 11, as well as dependent claim 15 (claim 12 is herein canceled and rewritten in independent form as new claim 36), particularly point out and distinctly claim the subject matter which Applicant regards as the invention and should no longer be viewed as indefinite. In reviewing Claim 11, Applicant also inserted the word "said" before the last reference to "account configuration data"

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to provide proper antecedent reference, and deleted the unnecessary phrase "means for" in the phrase "server memory means for" in order to further clarify that configuration data and recipient code data is stored in the server memory before the message arrives.

Applicant respectfully traverses the rejection of dependent claims 13 and 14 under 35 U.S.C. 112, second paragraph, because these are dependent from claim 9, not claim 11. Applicant submits that with the clarifying changes above to Claim 11 claim 15 is allowable.

With respect to claim 18, Applicant submits herewith an amendment to clarify that the user data on the wireless device is not necessarily the same as the user data on the server, and in fact the wireless device may not contain user data prior to receiving user data from the server.

In reviewing claims 19 and 20 in this context, Applicant noticed that they improperly referenced a "wireless device" rather than a "method" of claim 18, and submits herewith an amendment to correct these claims in this regard.

Claims 9, 10, 16, 17, 29, 33 and 35 are rejected under 35 U.S.C. 102(e) as anticipated by Ward et al. (U.S. 2003/0142215 A1). Applicant presumes that dependent claims 13 and 14 were inadvertently omitted from this list. Applicant respectfully traverses the rejection.

Ward is directed to a configuration file on a digital camera which contains information for transmitting images to a selected destination service (which Ward discloses may be an online service (ISP) or a digital photofinishing center (see abstract) and that "Multiple sets of destination services can be stored" (see paragraph 13)). Thus Ward discloses in paragraph 4 a configuration file that is created outside the digital camera "at a host computer and downloaded to a digital camera. This file contains instruction information for communicating with a selected destination via a communications interface".

Independent claim 9 distinguishes over Ward at least by reciting (a) "a memory that contains... an address associated with a remote server" and (b) "user interface means ... for at least displaying a list of recipient codes stored

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in said configuration table and receiving signals indicating user selection of at least one recipient code", and "processor control means, responsive to signals received from said user interface means, for transmitting one or more **messages including at least one recipient code** to said remote server". Ward's configuration files shown in figures 4A and 4B show a phone number but no address for a destination server, and therefore do not disclose a connection directly to a server at a particular address, per the present invention of claim 9. Rather, Ward discloses user selection of one of many destination services, each of which is presumably capable of appropriately handling images received from the camera. Note that at step 52 of Ward's Figure 2, the user is selecting an icon representative of the communication route or destination, each of which presumably corresponds to information in the configuration file which enables the Ward camera to connect to an associated destination service, so that one or more images can be transmitted to that destination. Ward's examples of what is in the configuration file include: "serial port baud rate, parity, and stop bits, as well as account name and password" (abstract and paragraph 4), "user account name and password, online service or internet service provider (ISP) phone number, and communications port settings" (claim 11), "protocol type, phone number, etc., as described in Appendix I." (paragraph 14), as well as what is shown in Appendix 1. Applicant respectfully submits that Ward did not contemplate nor disclose that it would be possible to contact the destination service provider using a server address per the present claim 9, and that to infer otherwise is only hindsight reconstruction.

Ward also refers to a "utilization file" in paragraphs 5 and 14. In paragraph 5 Ward discloses that the images can be either sent to the selected destination service **"immediately after the pictures are taken, for example if the camera has a built-in cellular phone modem, or at a later time, when the camera is connected to a separate unit (such as a dock, kiosk, PC, etc.) equipped with a modem. In the latter case, a "utilization file" is created to provide information on which images should be transmitted to which account".** This last sentence indicates to Applicant that the utilization file would be used only in the absence of

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a wireless network connection, and thus teaches away from the RF communications device of claim 9 when a utilization file is used.

Ward next mentions a "utilization file" in paragraph 14 where he discloses that: "The selected image files may be tagged with a code (step 56) indicating which service is requested, as shown in FIG. 3. (**Alternately**, an "image utilization" file can be created in the camera storing a list of images to be transmitted by a particular method, as described in the cross-referenced copending patent application (U.S. Serial No. 60/037,963). As described in that patent application, the details of an order, e.g., number of print copies to be made from an image and the size of the prints and/or a list of images to be e-mailed to various recipients, is written into the "utilization" file, which identifies the order and includes pointers to the image files that store the images required to "fulfill" the order. The "utilization" file is stored in the internal memory 28 or the memory card 30.)" Applicant submits that this is not a proper incorporation by reference of the entire Parulski 037,963 disclosure into Ward, and accordingly Ward only muddles his disclosure with this reference because the Ward disclosure otherwise presents inadequate information to describe what is in a utilization file, how it might be formatted, how it might be useful in image transmission, or whether the utilization file would include email addresses.

As stated in MPEP 608.01(p) "Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. In re de Seversky, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). In addition to other requirements for an application, the referencing application should include an identification of the referenced patent, application, or publication. Particular attention should be directed to specific portions of the referenced document where the subject matter being incorporated

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may be found." Without specifying what portion of the Parulski 037,963 disclosure is being incorporated, Ward only discloses that the utilization file may include a list of images to be emailed to various recipients, but does not clearly indicate that the utilization file contains anything such as a list of recipients to whom the images are to be sent.

Assuming for the sake of argument that even if this were a valid incorporation by reference of the entire Parulski 037,963 disclosure, Applicant submits that the use of the word "Alternately" in the above quote from Ward's paragraph 14 teaches that either (a) the image files are tagged with a code indicating a user selected destination service, or alternately (b) an image utilization file can be created that details what images are to be "transmitted" (and in this later case, it appears the utilization file must be transmitted or taken with the corresponding image file to the destination service, as in Parulski paragraph 19, first sentence). Applicant submits that (again, assuming for the sake of argument that the Parulski incorporation by reference were valid) Ward therefore teaches either selection of a destination service for each image as in Figure 3, or creation of an image utilization file that includes a list of images to be sent to various recipients and presumably some information that indicates how to send these images to a selected destination service. Therefore Applicant submits that Ward contains no clear disclosure or teaching of an apparatus as in present Claim 9, where message communication is via a server at a server address and the message/utilization file includes one or more recipient codes selected from a previously established configuration table.

Accordingly, Applicant respectfully submits that the invention of Claim 9 is not anticipated by Ward.

Claims 10, 13 and 14, as previously presented and as amended, depend from Claim 9 and Applicant respectfully submits that these are patentable over Ward for at least the same reasons that Claim 9 is patentable over Ward.

Independent claim 16 is amended herein on line 3 to clarify that the network is a wireless network and to establish prior antecedent basis for the

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wireless network recited on line 8. Applicant submits that Claim 16 distinguishes over Ward, because the method of Claim 16 is directed to transmitting a message to a remote system associated with a predetermined address. Claim 16 recites the step of "transmitting said message via said wireless network to said remote system" (which remote system is by definition associated with a predetermined address). Conversely, the primary feature of Ward's disclosed method involves a step where the user selects a destination service icon. The Ward configuration file "contains instruction information for communicating with a selected destination via a communications interface." Thus Ward discloses a method which uses the selected destination service icon to retrieve associated data (instruction information) in the configuration file in order to connect to a corresponding destination service. Ward teaches that this destination service is one of a plurality of choices available to the user, and thus Ward does not disclose the method of present Claim 16 which transmits a message to a remote system associated with a predetermined address which is not user-selected. Consequently, the Claim 16 address and remote system are always the same, regardless of what recipient code is selected, and in Claim 16 there is no selection (as in Ward) of a destination service.

Furthermore, as argued above in relation to Claim 9, Applicant submits that Ward does not disclose storing an address associated with a particular destination service in the Ward configuration file. Further, Ward does not disclose a connection with a wireless network.

Applicant also submits that as previously stated in relation to Claim 9, Ward's incorporation of the Parulski utilization file disclosure is imperfect and therefore does not read on the recipient codes of Claim 16, and even if this were a valid incorporation of some of the Parulski disclosure, such utilization file as disclosed by Ward or Parulski does not contain information that is analogous to the recipient code element of Claim 16.

For these reasons, Applicant submits that the method of Claim 16 is patentably distinct from the method of Ward, and as presently amended is in condition for allowance.

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Claims 17 and 35, as previously presented, depend from Claim 16 and are patentable over Ward for at least the same reasons that Claim 16 is patentable over Ward.

Independent claim 29 distinguishes over Ward primarily because it discloses a method that recites a first user input for selecting a recipient representation and recites a second user input, where according to the claimed method three things happen in response to each second user input (image is captured, message including image is formatted, and message is transmitted). Ward discloses selection of a destination service icon (which could be viewed as a first input per Fig. 2, step 52), and discloses a send button (which could be viewed as a second input per Fig. 2, step 58) that triggers transmission of images to the destination service. However, Ward clearly discloses in Figure 2 that the images are captured (step 50) not after but prior to the send button request (step 58). Thus, the timing of steps in the method of claim 29 is patentably distinguishable over the method disclosed by Ward, and Claim 29 is allowable over Ward.

Independent claim 33 distinguishes over Ward at least by reciting a distribution mechanism that is patentably distinct from the distribution mechanism described by Ward. In particular, Ward does not store data corresponding to a selected recipient, and then distribute this data, with the next image formed by the digital camera, to a networked computing device. Applicant respectfully submits that Examiner is incorrect in the latest Office Action where he states on page 9 that "if the send command is not entered in the step 58, the digital camera 10 is allowed to form the next image, and the steps 60-64 show that camera is distributing the data to the networked computing device". Rather, Applicant submits that figure 2 indicates that, if at step 58 the send command is not entered, then steps 60-64 are not executed. That is, according to Figure 2, there is always a send command prior to execution of steps 60-64.

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Ward further indicates in paragraph 14 that if at step 58 there has been no send command, "the image and associated data is stored in either permanent memory 28 or the memory card 30 (step 59). (Typically, all images are initially saved in memory whether eventually sent or not.)" Ward goes on to disclose that: "if there is a request to send an image, the user ensures that the camera is connected to the appropriate service (wired telephone line, cellular phone, kiosk, etc.) and pushes a "send" button in the user button section 26, or selects a "send" menu option on the LCD 24. The camera then utilizes the appropriate network configuration file, shown in FIG. 4. Each network configuration file contains items such as the protocol type, phone number, etc., as described in Appendix I. The user password may be checked against the password in the network configuration file to ensure that the user is authorized to connect the camera to the desired service (step 60). Alternately, the stored password in the appropriate configuration file can be used. Next, the camera uses the parameters in the configuration file to establish communications with the service and send one or more image files as selected by the user (steps 62)." The underlined text above seems redundant, since this is what's supposed to follow a request to send an image, but that's what Ward says. At any rate, Ward clearly contemplates a camera where image distribution is triggered by at least one 'send' command. Applicant submits accordingly that claim 33 is allowable over Ward, as the digital camera of Claim 33 distribution is triggered by formation of an image, rather than by a send command.

Claims 21, 23, 24, 25, 26, 30 and 31 are rejected under 35 U.S.C. 102(e) as anticipated by Parulski et al. (U.S. 2003/0025808 A1). Parulski discloses a utilization file that allows the user to "select 'downstream' services at the time of capture" and create print/ transmission/ albuming orders on a camera.

Claim 21 distinguishes over Parulski '808 at least by reciting "transmitting a message including at least one digital image and at least one code to a predefined remote server". Applicant submits that Parulski discloses nothing of transmitting a message to a predefined remote server. In fact, it's rather mysterious how the user knows how to transmit a utilization file to a "downstream

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service provider" as discussed in Parulski. Parulski says in paragraph 16 that a PC application allows the user to specify the "name(s) of downstream service providers", but Applicant submits that is not the same as the predefined remote server which the present specification discloses is at an address stored in the digital apparatus. In paragraph 24 Parulski discloses that the camera could alternately connect to an ISP, that in turn would communicate with the service provider. In either case, Applicant submits Parulski does not inherently use a method where images and the utilization file are transmitted to a remote server that is predefined on the camera, because a predefined remote server is not necessarily present for the Parulski method to work, nor is it necessarily present because the utilization file contains name(s) of downstream service providers. Alternate methods could be employed, for example the user could specify a service provider and corresponding server address prior to transmitting images, or the applicable remote server could be located via a look-up table in a Kiosk. Accordingly, Applicant submits that Claim 21 is allowable over Parulski.

Prior claim 22 is canceled herein and rewritten in independent form as new claim 37.

Claims 23 and 24 depend from Claim 21 and Applicant respectfully submits that these are patentable over Parulski for at least the same reasons that Claim 21 is patentable over Parulski. Claim 23 is amended herein to establish proper antecedent basis for "said code" (line 3) and "said at least one image" (lines 4 and 6), and to clarify that a message is sent to each selected set of recipients.

Applicant submits that Claim 23 further distinguishes over Parulski '808 at least by reciting additional server processing steps that are not disclosed by Parulski. Namely, "selecting... one set of recipients corresponding to said code to whom said at least one image is to be sent" represents a processing step that is not disclosed by Parulski. Parulski indicates in Fig. 2 that the user should somehow be able to define image access rights by selecting on the camera keyword descriptors such as Family/Friends; however there is no disclosure of how this information might be used on the server, or how it might relate to

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sending images to individuals that are somehow associated with such keyword descriptors. Parulski also indicates in Fig. 2 that images can be sent to recipients represented by codes *displayed on the camera* as "Grandma", "John", "Boss", or "Client", and in Fig. 4 that the utilization file can contain specific recipient email addresses. Further, Parulski does disclose in paragraph 24 that the ISP server could email images "using the data and images in the **utilization file**." This only indicates to Applicant that the Parulski utilization file can be parsed on the server, in order to use the code/email address contained therein and reformat it into an email message that includes associated images. Applicant respectfully submits that Parulski does not disclose or necessarily involve the steps of selecting one or more recipients (that per the present disclosure are on the server, but not in the message) corresponding to a code (in the message) and sending a message to the selected recipients. Applicant submits that this step as disclosed, and recited in Claim 23, makes the invention of Claim 23 allowable over Parulski.

Independent Claim 25 distinguishes over Parulski by defining a method for transferring information within an image file name, as disclosed where the present disclosure says "an image file may be assigned a unique file name, including the account ID, recipient code, and an image identifier, for later transfer via FTP Put command to the server 140." Applicant can find no such disclosure in Parulski. In Claim 25 essentially all that is transferred to the server is an image file, with a unique file name where such file name itself includes coded information, and respectfully submits that Claim 25 is allowable over Parulski.

Claim 26 depends from Claim 25 and Applicant respectfully submits that this Claim is patentable over Parulski for at least the same reasons that Claim 25 is patentable over Parulski.

Claim 30 defines a method in a data processing system which inherently comprises a first processor, such as a PC or laptop, where the processing begins, and a remote server. Claim 30 is herewith amended to correct references to "said remote system" by replacing this with "said remote server" in order to

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properly refer back to the "remote server" first introduced in step b) (2) of this claim. The first patentable distinction here is that this system does not necessarily include a camera, whereas the Parulski disclosed apparatus includes a digital camera and utilization file. On the contrary, this method begins in the first processor with receipt of a digital image from a digital camera that is in communication with, but not a defined element of, the system. Next in step 'b)' the processor automatically (1) formats and (2) transmits a message (including the digital image and a preselected code) to a remote server at a predetermined address, where the message is processed according to data on the remote server that is associated with the code in the message. Examiner has interpreted this to mean the steps (1) and (2) above are performed automatically on the remote server, but clearly this is done on the first processor of the Claim 30 system method, prior to transmitting to the remote server. Applicant submits that the method of Claim 30 clearly indicates only step 'c)' occurs on the remote server/ service provider, and Claim 30 is therefore patentable over Parulski.

Applicant further submits that the method of Claim 30 is patentably distinguishable from Parulski because the Claim 30 method uses a preselected code, that is, a code selected before the system receives a digital image. See the current application specification page 23, which says in part "the user will be able to operate the wireless device 110 interface in order to select a recipient code, mode, and classification, as described in relation to figures 4 - 6. If this step is skipped, the default values for any transmitted messages will be respectively set for HOLD, SEND, and NONE. The user will then be able to activate the camera by pressing the send key 196, which will activate processing of Figure 12 subsequent to block 406 in order to capture an image and transmit it as part of a message to the server 140 for processing and distribution according to the selected recipient code as described in relation to figure 20." Parulski discloses a process in paragraph 17 whereby one or more images are captured, and then order information ("code", if you will) is composed for these images and written to the utilization file. Next, per (paragraphs 19+) the images and utilization file are taken or transmitted to the

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service provider. Applicant submits that for this reason also, Claim 30 is allowable over Parulski.

Claim 31 depends from Claim 30 and Applicant respectfully submits that it is are patentable over Parulski for at least the same reasons that Claim 30 is patentable over Parulski.

Independent Claim 32 is rejected under 35 U.S.C. 102(e) as being anticipated by Squilla et al. (U.S. 6,396,537). Applicant submits that the method of Claim 32 is patentably distinguishable over Squilla because in the method of Claim 32, both a user ID and user preference data are established on the server, and only user preference data is transferred from the server to the rental device in order to update the rental device. However, Squilla never discloses or teaches that it would be beneficial to transfer preference/personality data from the server to the rental device. Rather, Squilla teaches transferring personality data in the opposite direction – from the camera to the site – and the site uses this personality data to select "content data" related to the site that would likely be of interest to the user, and either store this content data with the image on the server, or transfer the content (not personality) data back to the camera.

It appears to Applicant that Squilla discloses two configurations for operation, one where the camera operates with an "image spot", independently of a server (Fig. 1 description, col. 3, lines 57-60), and a second (shown in Fig. 2) where the camera operates in connection with a server that is connected via a network to various image spots (col. 5, lines 45-52). In each mode, personality data can be stored on the camera, although in the second configuration it can only be on the server (Col. 6, lines 51+). However, in neither of these configurations does Squilla teach that personality data is transferred from the server to the camera. Squilla discloses (Column 7, lines 32-35) that in Fig. 2 (where personality data may be initially created on the server) "the personality file 52 in the camera 24 or 26 would merely store a personal identifier that uniquely relates the camera 24 or 26 to the particular personality file 96 in the file server 70." Applicant notes a confusing aspect of Squilla is the use of two similar terms – personality

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data and personality file – and it's unclear to Applicant if this is meant to indicate a file that contains data, or if they are meant to be used interchangeably. Regardless, Applicant submits that Squilla does not disclose or suggest transfer of user preference data (as either a personality file or as personality data) from the server to the rental device, but rather implies only the transfer of a personal identifier from the server to the device (which identifier is not disclosed by Squilla to be personality data in the list beginning at bottom of column 6). Accordingly Applicant submits that the method of Claim 32 is distinct from Squilla due to transfer of the user preference data to the rental device in Claim 32, and Claim 32 is therefore allowable over Squilla.

Claims 1-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safai '469 in view of Korpela et al. (U.S. 6,167,283). Applicant respectfully traverses this rejection.

Safai '469 is directed to a digital camera that includes means for entering an email address and transmitting digital images to that address. Korpela '283 is directed to a method in a cellular terminal for selecting a particular cell base station with which to establish a communication connection, based either on a user profile in the terminal memory or based on user selection of what type communication is to be conducted.

Independent Claim 1 distinguishes over Safai at least by reciting "processor control means for ... establishing a persistent link between said RF communications device and an external network when the apparatus is first activated and thereafter whenever the processor detects that the external network is not available."

Examiner states that Safai '469 discloses the use of different RF links... to establishing a communication link between the wireless communication device of the Camera 104 and the remote system ... associated with the remote destination address"... and that "the persistent communication link... is constantly established when the communication device of the camera is first turned on for transmission." Examiner states that "the camera has to be turned

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on to download the image data" but concedes that Safai does not explicitly state that "the communication link is established whenever the processor detects the external network is not available". However, Examiner cites Korpela as teaching establishing this persistent link when the apparatus is first activated and thereafter whenever the processor detects that the external network is not available, and concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Safai as taught by Korpela so that it would provide better communication that best matches the user profile and terminal capability as suggested by Korpela (col. 4, lines 24+).

As previously argued by Applicant, Safai does not disclose an 'always on' e-camera, with an enduring network connection, but rather, Safai teaches away from this by saying at col. 12, line 17+, "the user is expected to connect a cable from the camera to a telecommunication device or network. For example, when communication port 214 is a modem, the user connects it to a telephone jack that is coupled to the public switched telephone network". While Safai does say at col. 18, line 13 "Wireless links may also be implemented" this does not begin to describe the function of the present invention that automatically establishes a wireless packet data network connection via wireless link whenever the apparatus is activated and environmental conditions permit establishing such a connection, without requiring any subsequent user action to re-initiated the link if it is subsequently lost and recovered, per the invention of Claim 1 as presently amended. On the contrary, Safai at col. 13, lines 10+ and 41+ teaches dialing a predefined telephone number, and terminating the connection following transport at col. 14, lines 3+.

In order to establish obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Applicant submits that it would not have been obvious to apply cell phone technology from Korpela to a digital camera system as described by Safai, because the technologies for handling of digital images were

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at the time of the invention distinct from cell phone technologies, and because there is no suggestion or motivation in either of the cited references that would result in such a combination. Applicant notes that although the Safai disclosure lists a fairly exhaustive description of possible communications port 214 technology... "The CPU is also coupled to input/output devices such as a communications port 214. For example, the CPU 210 is coupled to a telephone line 212 through a modem comprised of a coder/decoder (codec) and digital to analog adapter (DAA). Using the modem, the CPU 210 can communicate data over a conventional telephone line to a remote device such as a server, personal computer or workstation, or printer. A modem is merely one example of a device suitable for use as communications port 214. Alternatively, the communications port 214 is an infrared communications device, an Ethernet interface, an ISDN terminal adapter, or another telecommunications device" Safai does not appear to contemplate that communications port 214 could have even been a cellular connection. While Safai does indicate that "Wireless links may also be implemented." for the communication interface 718, this seems to be mentioned more as an afterthought, and certainly should not be construed as a teaching that a wireless link could be the means for providing an improved solution to the problem which Safai addressed. Applicant is unable to interpret the single Safai reference to "wireless links" as providing any teaching or suggestion that cellular communications were preferable to other communication channels, and certainly this single reference doesn't provide a suggestion or motivation to establish a persistent wireless connection, by combining Korpela technology, which is directed to optimizing a cellular network connection, with the Safai digital camera. Further, Applicant submits that the understandings, expectations and knowledge generally available to those of ordinary skill in the art of digital imaging at the time of the present invention taught away from use of cellular transmissions as a means of communications for digital images or other large data files. Most cellular communications were analog at the time and were charged by the minute, which expense tended to minimize the practicality of cellular data transmissions. Although CDPD was available at the time, it was a new technology and was only available in isolated areas. In this regard,

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Applicant notes that Korpela was filed in the US approximately one month prior to the present invention and it seems unlikely the subject matter of the Korpela disclosure was generally known at the time of the present invention. In fact, Applicant understands that the first high speed "3G" cellular network was commercially launched by NTT DoCoMo in Japan in October 2001. Thus Applicant submits that there was no suggestion or motivation, either in Safai or Korpela, or in the knowledge generally available to one of ordinary skill in the art of digital imaging at the time of the invention, to modify or combine the Safai and Korpela teachings in order to arrive at the present invention, and accordingly the invention of Claim 1 should be allowed over these references.

Claims 2-6 and 8 depend from Claim 1 and Applicant respectfully submits that these are patentable over Safai in view of Korpela for at least the same reasons that Claim 1 is patentable over Safai in view of Korpela.

Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward (US 2003/0142215) in view of Korpela (US 6,167,283). Applicant respectfully traverses these rejections.

Regarding independent claim 27, Examiner states that Ward does not explicitly state "the communication link is established whenever the processor detects the external network is not available" as recited in Claim 27, and then cites Korpela as evidence that this limitation was well known in the art at the time of the invention of claim 27. As discussed earlier (in relation to Claim 1), in order to establish obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Applicant finds nothing in Ward that teaches or suggests it would be of value in some way or improve the Ward disclosure to make the communication link persistent whether by using cellular or other communication channels. There would be no motivation to seek out this feature, because as earlier stated, the knowledge generally available to one of ordinary skill in the art at the time of the present invention taught away from, rather than toward, the use of cellular

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transmissions as a means of communications for digital images or other large data files. Most cellular communications were analog at the time and were charged by the minute, which expense tended to minimize the desirability of cellular data transmissions. In fact, the Ward reference to settings included in the configuration file (serial port baud rate, parity, and stop bits,) indicates to Applicant that Ward clearly contemplated establishing an analog modem connection, and any references to cellular connections were made as an afterthought. Applicant is unable to find a way to view the few references to cellular communications in Ward (paragraphs 5, 12, 14) as providing any teaching or suggestion that cellular communications were preferable to other communication channels, and certainly these don't provide a suggestion or motivation to establish a persistent wireless connection. Although CDPD was capable of providing a persistent wireless connection and was available at the time, it was a new technology and was only available in isolated areas, and other wireless data services of today were not yet available or generally known. Applicant thus submits that there was no suggestion or motivation, either in Ward or Korpela, or in the understandings, expectations and knowledge generally available to those of ordinary skill in the art of digital imaging at the time of the invention, to modify or combine the Ward and Korpela teachings in order to arrive at the present invention of Claim 27, and accordingly Claim 27 should be allowed over these references.

Alternately, Applicant further submits that Claim 27 is patentable at least by reciting "processor control means for... saving said image in said memory with a file name including at least one predefined code". Applicant can find no such disclosure in Ward. According to the invention of Claim 27, Ward may disclose transferring various information in a network configuration or a utilization file, but Applicant can find nothing similar to the present invention whereby information (predefined code) is transmitted as part of a file name. Applicant respectfully submits that this claim limitation alone is sufficient for Claim 27 to be allowable over Ward.

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Independent Claim 28 is directed to a method that corresponds somewhat to the apparatus of Claims 27 and 1. As stated earlier, Applicant finds nothing in Ward that teaches or suggests it would be of value in some way or improve the Ward disclosure by making the communication link persistent whether by using cellular or other communication channels. Applicant is unable to find a way to view the few references to cellular communications in Ward (paragraphs 5, 12, 14) as providing any teaching or suggestion that cellular communications were preferable to other communication channels, and certainly these don't provide a suggestion or motivation to establish a persistent wireless connection. For the reasons discussed earlier in relation to claims 1 and 27, Applicant thus submits that there was no suggestion or motivation, in Safai, Ward or Korpela, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention, to modify or combine their teachings in order to arrive at the present method of Claim 28, and accordingly Claim 28 should be allowed over these references.

Claim 28 should also be allowable over Ward in view of Korpela because it recites steps of capturing, formatting and transmitting each image in response to a single user input. In this embodiment of the present invention images are automatically captured and transmitted to the remote system - with default attributes (recipient code/ classification) or attributes selected by the user before a picture is taken - without requiring additional user intervention after a picture is taken to select an image and address it. Applicant submits that this process is much simpler than the process disclosed by Ward where the user must go through separate steps to address, and then select photos to send.

Applicant submits that claim 28 is not obvious over Ward in view of Korpela because the element of claim 28 which recites the step of "in response to a signal from said user interface, 1) capturing a digital image, 2) formatting a message including at least one said digital image, and 3) transmitting each said message to said remote server via said external network" is not found in either Ward or Korpela. On the contrary, Ward teaches, in paragraphs 15-18, that "after

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the user selects the images to be sent and presses the "send" button, the camera performs the following steps without user intervention:

- 1) Read the appropriate connection parameters from the network configuration file (on the memory card 30 or internal camera memory 28), dial the phone and establish the connection to the destination service 14.
- 2) Read the user's account name and password and transmit these to "log-on" to the service 14.
- 3) Using the appropriate communications protocol (FTP, mailto, etc.), transmit the selected image or images to the destination service 14. "

Accordingly Applicant submits that Ward teaches the steps that are performed in response to a signal (pressing the send button) do not include "capturing a digital image" as per the method of Claim 28, and this claim limitation alone is sufficient for allowing Claim 28 over Ward in view of Korpela.

Claims 11, 13 and 14 are rejected under 35 U.S.C 103(a) as being unpatentable over Parulski '808 in view of Ward '215. As mentioned earlier in reference to Independent Claim 9, Claims 13 and 14 now depend from Claim 9, rather than 11, and Applicant believes this rejection of claims 13 and 14 is unintended. Applicant respectfully traverses the rejection of Claim 11 as being unpatentable over Parulski '808 in view of Ward '215.

First, Applicant submits that Claim 11 distinguishes over Parulski '808 at least by reciting a "destination address" or "control means for ... transmitting a message including at least said selected recipient code and one said digital image, to said destination address via said RF communications device". Applicant submits that Parulski discloses nothing of transmitting a message to such a destination address. While Examiner states that Parulski paragraph 16 discloses a destination address, as well as "one or more predefined recipient codes", this is not clearly the case. To the contrary, Applicant respectfully submits that Parulski only says in paragraph 16 that a PC application allows the user to specify "name(s) of downstream service providers, network addresses (friends, family or business associates) and related account information" (which can then be

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saved on in the camera or an attached memory card), and while it seems conceivable that network addresses of family, friends or business associates might be construed as being email addresses this is not the same as the recipient codes or destination address disclosed in the present invention, nor is the name of a downstream service provider the same as the destination address disclosed by the present invention.

In paragraph 24 Parulski discloses that the camera could alternately connect to an ISP that in turn would communicate with a service provider. In either case, Applicant submits Parulski does not directly or inherently disclose use of a destination address for the ISP or the service provider to whom images are to be transmitted, because a preset destination address is not necessarily present for the Parulski method to work. Alternate methods could be employed, for example the user could specify a service provider phone number or the applicable remote server could be located via a look-up table in a Kiosk. Accordingly, Applicant submits that Claim 11 is allowable over Parulski.

Second, Applicant submits that (a) the recipient code of the present invention is not disclosed by Parulski or Ward, and (b) even if there were a motivation to combine Parulski and Ward, this would not result in the current invention of Claim 11 because neither Parulski nor Ward disclose a transfer of messages with recipient codes from a wireless device to a server where messages are processed according to account configuration data associated with said recipient code.

Parulski discloses (paragraph 25) only that "The utilization order information is provided in the utilization file." However, in Applicant's opinion it takes quite a leap to move from the Parulski idea of transmitting all information needed for order fulfillment to the idea of transmitting only an image and a code to a predefined address, and then processing the image at a server at that address, based on server configuration data that is associated with the code in the message. Neither Parulski nor Ward disclose anything like the recipient code or "nickname" of the present invention as shown in present figures 8 and 9, where figure 8 is a summary screen showing several recipients, their associated

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recipient code/nickname, and primary email address, and figure 9 is a detailed view of one of these recipient records with a recipient code/nickname of 'Jeff' and multiple addresses which, if present, the server could use to deliver messages. Given the Parulski disclosure of a utilization file that contains email addresses and other fulfillment instructions, to Applicant the only obvious result of combining Parulski with Ward would be to format a utilization file that included email addresses, or albuming or print instructions, and send this file to a downstream service provider or ISP, where it presumably would be saved, printed, or forwarded based on the contents of the transmitted utilization file. Applicant submits that this is significantly different from the present invention of Claim 11, and does not include the element quoted above. Ward may disclose a configuration file, but it doesn't contain a code that corresponds to data stored at the downstream service provider, and the Ward configuration file is disclosed as residing only on the host PC (12) or camera (10), not on the service provider or ISP 14. For these reasons, Applicant respectfully submits that the invention of Claim 11 is not obvious over Parulski in view of Ward.

Claim 15 is currently rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski in view of Ward as discussed above and further in view of Harkins (U.S. 5,689,642). Applicant traverses this rejection for at least the same reasons given above regarding rejection of Claim 11 over Parulski in view of Ward.

Examiner states, regarding Claim 15, that the combination of Parulski and Ward discloses server control means to process messages, and further comprises an account configuration record "the network configuration files and the 'image utilization' as shown in Figs. 3 and 4 of Ward and Figs. 2 and 4 of Parulski" but Applicant submits that the network configuration file of Ward is not on the server/ISP and is only disclosed to be on the Camera 10 or PC 12. While the Parulski utilization file is transmitted to the server, as discussed above in relation to Claim 11, Parulski does not disclose that the server contains any data other than what arrives in the utilization file. Harkins, on the other hand,

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discloses receiver-defined profiles that improve communications between devices or stations on a network, where users on the network may define preferences regarding how they wish to receive multimedia files originating from other users on the same network, and allows users to further define "receive priorities" as shown in Fig. 7 regarding whether communications from various other users on the network would be allowed direct or delayed access to messages. Thus, Harkins does not suggest that users could define preferences regarding messages received from users outside the network, as permitted by the present invention. Harkins discloses only a client-server architecture, rather than a store-and-forward system as contemplated by the invention of Claim 15. While Harkins does include the word "wireless" in the definition of "electronic mail" as a means of transmission, the Harkins email system 19 does not suggest support for wireless devices that are not connected to the network, and Applicant does not find anything in the Harkins disclosure that teaches that "direct access" messages would be forwarded to the wireless digital camera as in the present invention. Nor can Applicant find anything in Harkins, Parulski, or Ward, that would teach or suggest a motivation to combine their various teachings in order to arrive at the invention of Claim 15. Again for this reason Applicant respectfully submits that Claim 15 is allowable over Parulski in view of Ward and further in view of Harkins.

Claims 18 – 20 are rejected under 35 U.S.C 103(a) as being unpatentable over Ward '215 in view of Squilla (U.S. 6,396,537). Ward is directed to a camera configuration file that is intended to simplify the process of communicating with a selected destination service provider, whereas Squilla is intended to simplify the process of gathering and saving content information related to sites where photos are taken.

Examiner states that Ward discloses all elements of Claim 18, including wireless device whose memory contains an address associated with a remote server i.e. "remote computer 12 and server 14". Applicant respectfully submits that this remote computer 12 is separate and distinct from server 14, and while

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according to Fig. 1, the Ward camera 10 can be attached to the pc 12, and via communication network 40 to server 14, Applicant can find no Ward disclosure that teaches the camera 10 memory 28 contains an address associated with server 14. Applicant reiterates that, as discussed in relation to rejection of Claim 9 over Ward, Ward does not disclose that the camera 10 contains any such server address.

Applicant further contends that Ward does not disclose transmitting user data from the server 14 to the wireless device / camera 10. While Ward does say in paragraph 12 that "the network 40 can connect to the user's home PC 12" Applicant submits that this does not, directly or by inference, indicate or teach that data is transferred from the server 14 to the camera 10 (wireless device), and to the contrary, Ward clearly indicates in paragraphs 12 and 13 that user data is defined on the PC 12 and then transferred to the camera 10. Applicant references here the arguments made above in relation to the rejection of Claim 32 over Squilla that discuss the fact that Squilla does not disclose transfer of preference/personality data from the server to the camera, and submits that these same arguments apply equally well to the rejection of Claim 18 over Ward in view of Squilla. Thus, neither Ward nor Squilla disclose transmitting said user data from the server (service provider) to the wireless device (camera), and accordingly Claim 18 is not obvious over Ward in view of Squilla.

Examiner states in his rejection that Ward does not state that "RF communication is used to establish a communication link between the wireless device and the server as recited in the present claimed invention." Applicant further submits that Squilla seeks to solve a problem (i.e. simplify the process of gathering and saving information related to sites where photos are taken) that is so different from that of the present invention (prompt/simple photo distribution and archival) that it is non-analogous to the present invention, and even though Squilla mentions use of an RF communication device, Applicant submits that it would not have been obvious to one skilled in the art of Ward at the time of the invention (for example James D. Allen, who is a Ward and Squilla co-inventor) to combine the Ward disclosure with Squilla, and even if they did, the likely result

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would be a wireless transfer from Ward PC 12 to camera 10, rather than the invention of claim 18 that transmits data from the server to the wireless device. To say that combining Ward with Squilla would result in the invention of Claim 18 is mere hindsight reconstruction. Accordingly, Applicant submits that claim 18 and dependent claims 19 and 20, as presently amended, are allowable over Ward in view of Squilla.

Prior claims 12 and 22 are herein canceled and rewritten in independent form as new claims 36 and 37, and should be in allowable form as indicated in paragraphs 15 and 16 of the prior Office action. Claim 34 was previously allowed. For the reasons explained herein, Applicant respectfully submits that the present Claims 1- 6, 8 - 11, 13-21, and 23-37 are not anticipated by nor obvious over the cited prior art references, and are now in a condition for allowance.

Respectfully submitted,



Andrew T. Knowles (Applicant)

(919) 345-8816